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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/585,090

06/30/2006

Nobuyuki Tonegawa

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EXAMINER

FAN, HUA

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/585,090	<b>Applicant(s)</b> TONEGAWA, NOBUYUKI	
	<b>Examiner</b> HUA FAN	<b>Art Unit</b> 2456	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 9-13 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-8 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/11/2007</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, Species II in the reply filed on 4/21/2010 is acknowledged. The examiner included claims 16 and 17 in Group I, Species II, because they alternatively depend on claim 14; however, the applicant indicated their intention of not including claims 16 and 17 in Group I, Species II (see applicant's response on 4/21/2010, page 2), therefore claims 16 and 17 are treated as non-elected claims. As a result of this election, claims 1-3, 9-13 and 15-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/21/2010. Claims 4-8 and 14 are being examined, rejections set forth below.

### ***Claim Objections***

2. Claim 8 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4-8 and 14 are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 4 and 14 are means (or step) plus function claims that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function.

**Claim 4 recites “designation means for designating a kind of language of the text information input by said input means from a plurality of choices; embedding means for embedding the extracted text information in a text of e-mail using character codes of the type recognized by said recognition means, and describing the recognized type of character code and an identifier indicating a description range of the extracted text information in the text of e-mail”.** This limitation invokes 35 USC § 112, ¶ 6 because it meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase “means for” or “step for” (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see *Altiris Inc. v. Semantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003).

**Claim 14 recites functional language "designation step of designating a kind of language of the text information input in the input step from a plurality of choices; an embedding step of embedding the input text information in a text of e-mail in a ccordance with the kind of langue designated in the designation step, and describing a type of character code corresponding to the designated kind of language and a description range of the input text information in the text of e-mail".** Although the phrase "means for" or "step for" is not used in this limitation, the claim limitation is written as a function to be performed and does not recite sufficient structure, material, or acts for performing the claimed function which

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would preclude application of 35 U.S.C. 112 six paragraph. Therefore claim 14 is considered invoking 35 USC § 112, ¶ 6 as well.

35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. “If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112.” *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, six paragraph; or

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(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP 2181 and 608.01(o).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 4, 6, 8, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Feng GuangMing (Koumei Hyo, “Chinese writer V4, Standard Multilingual word processor with a

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further improved level completion”, translated version in English. The original in Japanese submitted by IDS).

As to claim 4, Feng discloses a communication apparatus, characterized by comprising:  
input means for inputting text information (page 17, screen 9 "Online Chinese handwriting input");

designation means for designating a kind of language of the text information input by said input means from a plurality of choices (page 17, screen 11 "Language selector");

embedding means for embedding the input text information in a text of e-mail in accordance with the kind of language designated by said designation means (page 18, screen 13, "preparation of e-mail in Chinese"), and describing a type of character code corresponding to the designated kind of language and a description range of the input text information in the text of e-mail (page 7, screen 2, line 2, 8, 10, and 12, these lines indicate both type and range, according to page 6, paragraphs 3-4, "Big-5...GB certainly will be prepared at 'E00X0404' and 'E00X0804'");  
and

sending means for sending e-mail data embedded by said embedding means (page 18, screen 13, "preparation of e-mail in Chinese" implies sending email data).

As to claim 14, see similar rejection to claim 4.

As to claim 6 (when depends on claim 4), Feng discloses the apparatus according to claim 4,

characterized in that said designation means designates the kind of language on the basis of an operator's instruction (Feng, page 13, paragraph 2, "language selector...one-touch switch

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among Chinese Write V4 (CW)...and Chinese and Japanese fonts". One-touch switch indicates an operator's instruction).

As to claim 8 (when depends on claim 4), Feng discloses the apparatus according to claim 4, characterized in that the e-mail data is divided into a plurality of parts, and said embedding means can describe difference types of character codes for respective parts (Feng, page 7, screen 2, lines 2, 8, 10, and 12).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feng, as applied to claim 4 above, and further in view of Ayako (JP 10177623, "Document recognizer and language processor", translated version in English. The original is in Japanese, submitted by IDS).

As to claim 5, Feng discloses substantially the claimed invention, but does not expressly disclose scan means for inputting image information obtained by scanning an image on a document; and recognition means for recognizing text information included in the image information input by said scan means, wherein said input means inputs the text information recognized by said recognition means.

Ayako discloses scan means for inputting image information obtained by scanning an image on a document (page 15, last line to page 16, first 2 lines); and

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recognition means for recognizing text information included in the image information input by said scan means (page 16, last 6 lines),

wherein said input means inputs the text information recognized by said recognition means (page 21, paragraph 2, lines 3-4).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the teachings disclosed by Feng, with the teachings disclosed by Ayako regarding scan means for inputting image information obtained by scanning an image on a document; and recognition means for recognizing text information included in the image information input by said scan means, wherein said input means inputs the text information recognized by said recognition means. The suggestion/motivation of the combination would have been to be able to read image data (Ayako, page 16, lines 1-3).

As to claim 6 (when depends on claim 5), Feng-Ayako discloses the apparatus according to claim 5,

characterized in that said designation means designates the kind of language on the basis of an operator's instruction (Feng, page 13, paragraph 2, "language selector...one-touch switch among Chinese Write V4 (CW)...and Chinese and Japanese fonts". One-touch switch indicates an operator's instruction).

As to claim 7, Feng-Ayako discloses the apparatus according to claim 5, characterized in that said designation means designates the kind of language on the basis of a dictionary for recognition used in said recognition means (Feng, page 11, paragraph 3 "Dictionary look up" function).

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As to claim 8 (when depends on claim 5 or 7), Feng-Ayako discloses the apparatus according to claim 5 or 7, characterized in that the e-mail data is divided into a plurality of parts, and said embedding means can describe difference types of character codes for respective parts (Feng, page 7, screen 2, lines 2, 8, 10, and 12).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUA FAN whose telephone number is (571)270-5311. The examiner can normally be reached on M-F 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art Unit  
2400

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